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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): 1039SUS01

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Application Number	Filed
10/730,698	12/8/03

First Named Inventor: Jason D. Hanzlik et al.

Art Unit	Examiner
3654	Haugland, Scott

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- ☒ attorney or agent of record. Registration number 35,814
- ☐ attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

Eric Levinson
Signature

Eric D. Levinson
Typed or printed name

651/704-3604
Telephone number

2/12/7
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Jason D. Hanzlik et al.	Examiner:	Haugland, Scott J.
Serial No.:	10/730,698	Group Art Unit:	3654
Filed:	December 8, 2003	Docket No.:	10395US01
Title:	**TAPE REEL ASSEMBLY WITH WEAR RESISTANT DRIVEN TEETH**		

CERTIFICATE UNDER 37 CFR 1.8: I hereby certify that this correspondence is being transmitted by facsimile to the Commissioner for Patents, Alexandria, VA 22313-1450 on February 12, 2007.

By: _____
Name: Eric D. Levinson

Pre-Appeal Brief Request for Review

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Pre-Appeal Brief Request for Review is filed concurrently with a Notice of Appeal.

A teleconference with the Examiner was held on February 6, 2007. Applicants' representative presented a line of reasoning asserting that the rejections to the independent claims under section 102 is in error, and requested that the Office provide a reason for rejecting claims that were newly presented in the Amendment and Response filed on September 25, 2006.

Reference is made to pending claims 1-2, 5-11, 14-18, and 23-29 as they appear in the Amendment and Response filed on September 25, 2006. The claims, including independent claim 1, 10, and 17, have been twice rejected under 35 U.S.C. § 102(b). We believe that rejecting the claims under Section 102 is clearly in error and request Pre-Appeal Brief review of all rejected claims.

Claims 1, 5, 6, 10, 14, 15, 17, 23, 25, and 26 were rejected under 35 U.S.C. § 102(b) as anticipated by Morita et al., U.S. Patent Publication No. 2002/0158161 ("Morita").

The Examiner takes the position in the Office Action mailed July 11, 2006 at page 3 that Morita discloses a hub (4, 6, or 21) that defines a tape winding surface and teeth (gear teeth 42 or

teeth 63) formed from a polymer including a lubricating additive. The Examiner maintains this position at page 2 of the Final Office Action mailed December 12, 2006. In particular, the Examiner asserts that the gear teeth 42 or teeth 63 are integrally formed with the hub 21 as shown by the hub portion 4 (in, for example, FIG. 2).

We maintain it is clear error that the examination has ignored express limitations of the pending claims, for example, giving no patentable weight to the claimed driven teeth of the claimed hub that in each independent claim require the driven teeth to be integrally formed by the hub.

Each of the pending claims requires a hub that defines a tape winding surface and includes **driven teeth integrally formed by the hub.** The Examiner references teeth in Morita that 1) are not driven teeth; and 2) are not teeth integrally formed by the hub 21 of Morita.

With regard to Morita, neither the restraining member 4 (having teeth 42) nor the releasing member 6 (having teeth 63) is a hub that defines a tape winding surface. The restraining member 4 and the releasing member 6 combine to form a reel-rotation restraining means 10 (See Morita at FIG. 2). One of ordinary skill in the tape reel assembly art would recognize that the restraining member 4 and the releasing member 6 of Morita are brake components and not hub components.

The hub 21 in Morita is separate and distinct from the restraining member 4 and the releasing member 6 (See Morita at FIG. 3). FIG. 2 of Morita is an exploded perspective view of "the essential parts" showing the restraining member 4, the releasing member 6, and the reel gear 24 are each provided as separate components apart from the hub 21 (Morita at paragraph 0108). Thus, the teeth 42 and 63 relied upon by the Examiner are not **driven teeth integrally formed by the hub**, as required by independent claims 1, 10, and 17.

Regarding the limitations of the pending claims, nothing in Morita teaches or suggests a hub defining a tape winding surface, **driven teeth integrally formed by the hub**, the driven teeth extending relative to one of the opposing ends of the tape winding surface and defining an engagement surface, where **the driven teeth are formed from a polymer including a lubricating additive**, as required by independent claims 1, 10, and 17.

For these reasons, it is respectfully submitted that it is clearly in error to reject claims 1, 5, 6, 10, 14, 15, 17, 23, 25, and 26 under 35 U.S.C. § 102(b) over Morita.

Although the independent claims have not been rejected under § 103, the Examiner takes the position at page 5 of the Office Action mailed July 11, 2006 that even if the pending independent claims define over Morita, that it would be obvious to form the reel gear 24 teeth (*See* Morita at FIG. 1) of the same material as the restraining member 4 and the releasing member 6 to provide wear resistance for the reel gear 24 teeth. We respectfully disagree.

The hub 21 of Morita includes teeth 21a (or teeth 24). Morita is completely silent as to the composition of teeth 21a/24. Nothing in Morita teaches or suggests a hub defining a tape winding surface, **driven teeth integrally formed by the hub**, the driven teeth extending relative to one of the opposing ends of the tape winding surface and defining an engagement surface, where **the driven teeth are formed from a polymer including a lubricating additive**, as required by independent claims 1, 10, and 17.

Specifically, Morita discloses in paragraph 0119 that at least one of the restraining member 4 or the releasing member 6 includes a synthetic resin containing a lubricant. Morita asserts "this reduces the friction and wear between the sliding-contact portions of both." Thus, it is reasonable to conclude that Morita provides a synthetic resin containing lubricant in one of the restraining member 4 or the releasing member 6 to reduce the friction as these two components slide relative one to the other. In other words, it is the sliding wear or the sliding friction that Morita is motivated to reduce.

In contrast, Morita discloses at paragraph 0121 that the reel gear 24 chucks-up with the drive-side rotation drive means 11. The drive means 11 rotatably engages with the reel gear 24. Since the reel gear 24 teeth are not "sliding-contact portions," one of skill in the art would have no motivation to make the suggested combination. That is to say, there is no suggestion or motivation to provide the rotatable reel gear 24 with the resin containing lubricant since Morita teaches that the lubricant is provided to reduce sliding friction, and the reel gear 24 teeth are not sliding-contact portions. For at least this reason, the Examiner's alternative argument fails to establish a *prima facie* case of obviousness over Morita.

Nothing in the cited references would lead one of skill in the art to modify the hub teeth (21 or 24) in Morita to include a lubricating additive. Morita is silent as regards the composition of the teeth 21a/24 of the hub 21. Thus, any purported combination would merely affect the reel-rotation restraining means 10 of Morita (elements 4 and 6). That is to say, the brake assembly components would be modified and not the hub 21.

Claims 2, 7-9, 11, 16, 18, and 24 were rejected under 35 U.S.C. § 103(a) as unpatentable over Morita in view of Boutni.

The hub 21 disclosed in Morita does not include integrally formed driven teeth. In contrast, the brake components, i.e., the reel 2, the restraining member 4, and the releasing member 6, which are provided **separately and independently** from the hub 21, include teeth 24, 42, and 63, respectively. Morita is silent as regards material selection for the hub 21.

Boutni likewise fails to teach or suggest driven teeth integrally formed by a hub, and thus does not cure the deficiencies of the Morita disclosure.

Thus, the purported combination fails to teach or suggest all of the limitations of a hub integrally forming driven teeth at an opposing end of a tape winding surface, where the driven teeth define an engagement surface formed from a polymer including a lubricating additive, as required by amended independent claims 1, 10, and 17. Consequently, a *prima facie* case of obviousness cannot be established.

Applicants respectfully submit that there is no suggestion or motivation available in the cited references to modify any of the teeth disclosed in Morita (none of which are integrally formed by the hub 21) to include the additives taught by Boutni. In this regard, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not in Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); MPEP § 2143. Since Morita is silent as to the resin selection for the hub 21, there is no basis upon which to form a motivation to select materials for Morita, much less the specific materials taught in Boutni.

Moreover, even if the purported combination is made, the resulting device would merely provide the reel-rotation restraining means 10 of Morita (elements 4 and 6) with the polymer compositions taught by Boutni. That is to say, the brake assembly components would be

modified and not the hub 21. Thus, the purported combination would fail to provide a hub integrally forming driven teeth, where the driven teeth define an engagement surface formed from a polymer including a lubricating additive, as required by amended independent claims 1, 10, and 17.

We believe that additional patentably distinct limitations recited in the newly presented claims 27-29 of the Amendment and Response filed on September 25, 2006 were ignored in the Final Office Action mailed on December 12, 2006, which is believed to be error suited for review.

CONCLUSION

We respectfully submit that pending claims 1-2, 5-11, 14-18, and 23-29 recite patentable subject matter, are in form for allowance, and are not taught or suggested by the cited references. Therefore, reconsideration and withdrawal of the rejections and allowance of claims 1-2, 5-11, 14-18, and 23-29 is respectfully requested.

Respectfully submitted,

Date: 2/12/7

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